



Docket No.: 025122.0101P3US
(Previously 023004.0104P3US)
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of:
Michael W. Graham et al.

Application No.: 09/646,807

Confirmation No.: 1584

Filed: December 5, 2004

Art Unit: 1635

For: CONTROL OF GENE EXPRESSION

Examiner: B.A. Whiteman

**PETITION FOR UNINTENTIONALLY DELAYED
CLAIM FOR PRIORITY UNDER 37 CFR § 1.78(a)(3)**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The above-identified application may be construed to have an incomplete priority claim. The first paragraph of the current specification (as previously amended) reads "This application is the U.S. National Phase under 35 U.S.C. § 371 of International Application PCT/AU99/00195, filed March 19, 1999, which claims priority of Australian Provisional Application No. PP 2499, filed March 20, 1998. This application is also a continuation-in-part of U.S. Application No. 09/100,812 and U.S. Application No. 09/100,813, both filed June 19, 1998."

A declaration was filed with this application on December 5, 2000 listing priority to "Australian Patent Application No. PP 2492" and "Australian Patent Application No. PP 2499". See attached Declaration. However, reference to Australian Application PP 2492 was inadvertently omitted from the priority claim on the first page of the specification, as indicated above. This application number was omitted from the priority claim by Applicants' previous counsel. This omission was just discovered by Applicants' present legal representatives.

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As per 37 CFR §1.78(a)(3), we therefore submit a statement that the entire delay between the date the claim was due under paragraph 37 CFR (a)(2)(ii) and the date the claim was filed is unintentional. It is submitted, therefore, that on the basis described above the priority claim should be held to be inadvertent and the enclosed Amendment and Response should be entered.

An amendment is submitted concurrently changing the priority claim to accurately reflect the correct parent applications. The amended priority claim will now read:


“This application is the U.S. National Phase under 35 U.S.C. § 371 of International Application PCT/AU99/00195, filed March 19, 1999, which claims priority of Australian Provisional Application No. PP 2499 and Australian Provisional Application No. PP 2492, both filed March 20, 1998. This application is also a continuation-in-part of U.S. Application No. 09/100,812 (Now U.S. Patent 6,573,099) and U.S. Application No. 09/100,813, both filed June 19, 1998.”

Applicants' would also like to bring to the attention of the Commissioner that reference to the parent PCT application is not listed on the US PTO Patent Application Informational Retrieval system (PAIR). See PAIR printout.

Please charge our Credit Card in the amount of \$1,370.00 covering the fee set forth in 37 CFR 1.17(t). Credit Card Payment Form SB-2038, with a signature from an authorized cardholder, is enclosed. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-2228, under Order No. 025122.0101P3US.

Dated: December 28, 2006

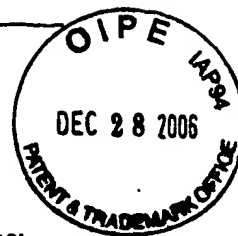
Respectfully submitted,

By 
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DECLARATION - USA PATENT APPLICATION



As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name;

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled CONTROL OF GENE EXPRESSION; the specification of which was internationally filed on March 19, 1999, as International Application No. PCT/AU99/00195, and for which the initial documents for entry into the U.S. National Phase were filed on September 20, 2000.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above;

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations, § 1.56;

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

PRIOR FOREIGN APPLICATION(S)

Priority
Claimed

No.: PP 2492	Country: Australian Prov Patent Appl	Date Filed: March 20, 1998	Yes
PP 2499	Australian Prov Patent Appl	March 20, 1998	Yes

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of first inventor: Michael Wayne Graham

Inventor's signature

Date _____

19 October 2000

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Full name of second inventor: Robert Norman Rice

Inventor's signature *Robert Norman Rice*

Date 19th October 2000

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PATENT
Attorney Docket No. 061610-0007-REX

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reexam Control No.:)
)
Patent No.: 6,573,099) Group Art Unit: Unknown
(Serial No. 09/100,812, filed June 19, 1998))
) Examiner: Unknown
Issued: June 3, 2003)
)
For: Genetic Constructs for Delaying)
or Repressing The Expression of a)
Target Gene)

U.S. Patent and Trademark Office
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REQUEST FOR REEXAMINATION
PURSUANT TO 35 U.S.C. §§ 302-307 and 37 C.F.R. § 1.510

Sir:

Reexamination of U.S. Patent No. 6,573,099 to Graham ("the '099 patent", Exhibit A) is requested in light of new prior art not considered during prosecution of the '099 patent. The '099 patent issued on June 3, 2003 and is being actively enforced by the assignee.¹

I. CLAIMS FOR WHICH REEXAMINATION IS REQUESTED

Reexamination of claims 1-22 of the '099 patent is requested in view of new, additional prior art listed on the enclosed Form PTO-1449. As explained in detail herein, these references anticipate or render obvious all of the independent and dependent claims of the '099 patent.

~~See, e.g., Benitec Australia Ltd. v. Nucleonics Inc. et al., Civil Action 04-174 (D. Del.) (JJE), filed March 22, 2004.~~